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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/698,813	10/30/2003	Donald H. Osterberg JR.	88325-761206 (067000US)	2479
51296 7590 07/27/2011 Kilpatrick Townsend & Stockton LLP/Oracle Two Embarcadero Center 8th Floor San Francisco, CA 94111-3834				
EXAMINER WHIPPLE, BRIAN P				
ART UNIT 2448		PAPER NUMBER		
MAIL DATE 07/27/2011		DELIVERY MODE PAPER		

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

# Office Action Summary

**Application No.**

10/698,813

**Applicant(s)**

OSTERBERG, DONALD H.

**Examiner**

Brian P. Whipple

**Art Unit**

2448

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 07 June 2011.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1.5-7.9, 21.22 and 25-28 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1.5-7.9, 21.22 and 25-28 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-940)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB-08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

### **DETAILED ACTION**

1. Claims 1, 5-7, 9, 21-22, and 25-28 are pending in this application and presented for examination.

### ***Response to Arguments***

2. Applicant's arguments with respect to claims 1, 5-7, 9, 21-22, and 25-28 have been considered but are moot in view of the new ground(s) of rejection.

### ***Claim Objections***

3. As to claims 1 and 5-6, claim 1 refers to "e-mail," but claims 5-6 refer to "email." For the sake of consistency, the claims should refer uniformly to either e-mail or email.

### ***Claim Rejections - 35 USC § 112***

4. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

5. Claims 1, 5-7, and 9 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

6. As to claim 1, line 5, the phrase “from source device” is ambiguous as it is unclear if a reference is being made back to the phrase “a source device” in line 3 of the claim. If this is so, then reference should be made through the use of a phrase such as “from the source device” or “from said source device.”

7. As to claims 5-7 and 9, the claims are rejected due to their dependency on, and therefore inclusion of, the rejected subject matter of claim 1 above.

8. The following is a quotation of the fourth paragraph of 35 U.S.C. 112:

Subject to the following paragraph, a claim in dependent form shall contain a reference to a claim previously set forth and then specify a further limitation of the subject matter claimed. A claim in dependent form shall be construed to incorporate by reference all the limitations of the claim to which it refers.

9. Claims 5 and 25 are rejected under 35 U.S.C. 112, 4th paragraph, as being of improper dependent form for failing to further limit the subject matter of the claim upon which it depends.

10. As to claim 5, the claim fails to further limit parent claim 1. The claim is directed to a “process in which an authorization indicator is generated,” but claim 1 refers to “generating an authorization indicator.”

11. As to claim 25, the claim is rejected for reasons similar to claim 5 above.

***Claim Rejections - 35 USC § 102***

12. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

13. Claims 1, 5-7, 9, 21-22, and 25-28 are rejected under 35 U.S.C. 102(a) as being anticipated by Garrigues, U.S. Publication No. 2003/0200267 A1.

14. As to claim 1, Garrigues discloses an unsolicited e-mail Internet protocol source address verification method (Abstract) comprising:

sending from a source device a request for authorization to send an electronic mail message ([0062]), the request identifying an address of the source of the request ([0026], ln. 1-2; [0027], ln. 3-5; [0054], ln. 19-22);

receiving at an e-mail authorization system from source device the request for authorization to send the electronic mail message ([0063], ln. 1-4);

authorizing the request with the e-mail authorization system including generating an authorization indicator that indicates the source of said request for authorization ([0063], ln. 16-20; [0069]);

receiving at the source device from the e-mail authorization system the authorization indicator ([0063], ln. 16-20; [0069]);

adding by the source device the received authorization indicator to an electronic mail message ([0008]);

sending the electronic mail message with the added authorization indicator from the source device to a destination device ([0008], ln. 7-8).

15. As to claim 5, Garrigues discloses the invention substantially as in parent claim 1, further comprising performing at the email authorization system an indication generator process in which an authorization indicator is generated ([0063], ln. 16-20; [0069]).

16. As to claim 6, Garrigues discloses the invention substantially as in parent claim 5, wherein said authorization indicator is a unique bit string and further identifies the email authorization system ([0028]).

17. As to claim 7, Garrigues discloses the invention substantially as in parent claim 1, further comprising tracking said source address with the e-mail authorization system ([0030], ln. 11-14; [0055]).

18. As to claim 9, Garrigues disclose the invention substantially as in parent claim 1, wherein generating the authorization indicator comprises:

extracting a request source address from said request ([0026], ln. 1-2; [0027], ln. 3-5; [0054], ln. 19-22); and

utilizing said request source address as a destination address in a header file of a return package including authorization indicator information ([0063], ln. 16-20; [0069]).

19. As to claim 21, the claim is rejected for reasons similar to claim 1 above.

20. As to claim 22, Garrigues discloses the invention substantially as in parent claim 21, wherein the destination device is adapted to handle receipt of the electronic mail message

([0065], ln. 6-10; [0068], ln. 3-7), including verifying the source address included in the received electronic mail message against the authorization indicator ([0068] – [0069]).

21. As to claim 25, the claim is rejected for reasons similar to claim 5 above.

22. As to claim 26, the claim is rejected for reasons similar to claim 6 above.

23. As to claim 27, the claim is rejected for reasons similar to claim 7 above.

24. As to claim 28, the claim is rejected for reasons similar to claim 1 above.

### ***Conclusion***

25. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. See the Notice of References Cited (PTO-892).

26. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).



A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

27. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Brian P. Whipple whose telephone number is (571)270-1244. The examiner can normally be reached on Mon-Fri (8:30 AM to 5:00 PM EST).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Firmin Backer can be reached on 571-272-6703. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Brian P. Whipple  
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Examiner, Art Unit 2448  
7/25/11

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